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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/828,694	04/21/2004	Bruce Nesbitt	0111339-029	5393

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EXAMINER	
TADESSE, YEWEBDAR T	
ART UNIT	PAPER NUMBER
1734	

DATE MAILED: 04/01/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action SummaryApplication No. 10/828,694

Applicant(s)

NESBITT, BRUCE

Examiner

Yewebdar T Tadesse

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If no period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-32 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-7, 9-11, 13-15, 18-25 and 27-30 is/are rejected.
- 7) ☒ Claim(s) 8, 12, 16, 17, 26, 31 and 32 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>4/04, 09/04 & 02/05</u> . | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Specification

1. Claim 24 is objected to under 37 CFR 1.75 as being a substantial duplicate of claim 23. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

Double Patenting

2. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

3. Claim 1 is rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1 and 7-11 of prior U.S. Patent No. 6,860,947. This is a double patenting rejection. Despite a slight difference in wording, claim 1 of the instant application covers the same invention as disclosed in claims 1 and 7-11 of US '947.

4. Claims 1-3 and 5-7 are rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 73-79 of prior U.S. Patent No. 6,860,947. This is a double

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patenting rejection. Despite a slight difference in wording, claims 1-3 and 5-7 of the instant application cover the same invention as disclosed in claims 73-75 and 78-79 of US '947.

5. Claims 9-11 are rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 80-81 of prior U.S. Patent No. 6,860,947. This is a double patenting rejection. Despite a slight difference in wording, claims 9-11 of the instant application cover the same invention as disclosed in claims 80-81 of US '947.

6. Claims 13-15 are rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 82-83 of prior U.S. Patent No. 6,860,947. This is a double patenting rejection. Despite a slight difference in wording, claims 13-15 of the instant application cover the same invention as disclosed in claims 82-83 of US '947.

7. Claims 18-20 and 22-25 are also rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 86-93 of prior U.S. Patent No. 6,860,947. This is a double patenting rejection. Despite a slight difference in wording, claims 18-20 and 22-25 of the instant application cover the same invention as disclosed in claims 86-88 and 91-93 of US '947.

8. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11

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F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

9. Claim 4 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 73-79 of U.S. Patent No. 6,860,947 as applied to claim 1 above further in view of Rangarajan et al (US 6,376,013). Claims 73-79 of US'947 discloses a coating means including a sprayer, however at least one sprayer (a plurality of sprayers) is not taught in '947. Rangarajan et al discloses a plurality of nozzles (see Fig 7) in applying coating material to the substrate. It would have been obvious to one of ordinary skill in the art at the time the invention was made to include at least one sprayer in '947 to facilitate the application of coating layer on the substrate.

10. Claim 21 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 86-93 of U.S. Patent No. 6,860,947 as applied to claim 1 above further in view of Rangarajan et al (US 6,376,013). Claims 86-93 of US'947 discloses a coating means including a sprayer, however at least one sprayer (a plurality of sprayers) is not taught. Rangarajan et al discloses a plurality of nozzles (see Fig 7) in applying coating material to the substrate. It would have been

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obvious to one of ordinary skill in the art at the time the invention was made to include at least one sprayer in '947 to facilitate the application of coating layer on the substrate.

11. Claims 27-30 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 82-84 of U.S. Patent No. 6,860,947 in view of Rangarajan et al (US 6,376,013), Subramanian et al (US 6,270,579) and Courtenay (US 5,902,399). Despite a slight difference in wording, claims 82-84 discloses every aspects of the claimed invention except at least one (a plurality of) atomizing sprayer, wherein each of the sprayers is operable to apply a different coating to the section of the part, each of the sprayer including a spray control which enables the sprayer to apply the coatings at different rate and the coatings including a base coating, a middle coating and a top coating. Rangarajan discloses (see Figs 4A, 6 and column 8, lines 30-63) a plurality of sprayers (nozzles 90) applying a different coating to the section of the part and the coatings capable of including a base coating, a middle coating and a top coating. It would have been obvious to one of ordinary skill in the art at the time the invention was made to include at least one sprayer in '947 to facilitate the application of coating layer on the substrate.

Subramanian et al also discloses a sprayer including a spray control (volume rate control 74 in communication a processor 74), which enables the sprayer to apply the coatings at different rate. It would have been obvious to one of ordinary skill in the art at the time the invention was made to include a sprayer including a spray control applying the coating at different rate in '947 to improve the uniformity of the thickness of the

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coating layer applied. As to the atomizing sprayer, it is well known in the art to use atomizing sprayer to apply coating material onto a substrate; for instance – Courtenay discloses (see Fig 3) an atomizing sprayer (40). It would have been obvious to one of ordinary skill in the art at the time the invention was made to include an atomizing sprayer in '947 to dispense the coating solution in the form a fine mist in a dispersed and divergent pattern (see column 4, lines 43-47).

Allowable Subject Matter

12. Claims 8, 12, 16-17, 26, and 31-32 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

13. The following is a statement of reasons for the indication of allowable subject matter: Aindow et al (US 5,375,613) discloses (see Fig 12) an air mover 214 for removal of contaminants in the production of perforations a target cigarette by a laser beam in manufacturing cigarette. Aindow does not disclose an excess coating reducer including air mover for the laser receiver housing. Prior art of record does not disclose or suggest a coating apparatus comprising, among others, an excess coating reducer including an air mover.

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yewebdar T. Tadesse whose telephone number is (571)

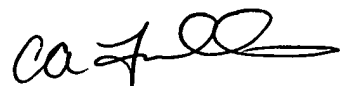
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272-1238. The examiner can normally be reached on Monday-Friday 8:00 AM-4: 30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chris Fiorilla can be reached on (571) 272-1187. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


YTT


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